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EXAMINER

WOO, RICHARD SUKYOON

ART UNIT

PAPER NUMBER

3629

DATE MAILED: 10/08/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/576,686

Applicant(s)

DARCY ET AL.

Examiner

Richard Woo

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-42 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-42 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on ____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) ____.
- 4) ☐ Interview Summary (PTO-413) Paper No(s) ____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Specification

1) The lengthy specification has not been checked to the extent necessary to determine the presence of all possible minor errors. Applicant's cooperation is requested in correcting any errors of which applicant may become aware in the specification.

Claim Rejections - 35 USC § 101

2) 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

3) Claims 21-29 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

In Claim 21, the computer-readable medium itself can not be directed to a practical application of the invention in the useful art to accomplish a concrete, useful, and tangible result. When the computer program is actually executed by the computer, the claimed subject matter produces a useful, concrete and tangible result.

Claim Rejections - 35 USC § 112

4) The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

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5) Claims 23-29 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In Claim 23, line 2, the recitation of "the equipment" lacks antecedent basis.

Claims 24, 25, 26, 27, 28 and 29 suffer the same indefiniteness as cited above.

Claim Rejections - 35 USC § 102

6) The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

7) Claims 1-42 are rejected under 35 U.S.C. 102(e) as being anticipated by Saari et al. (US 6,338,046).

W.R.T. Claims 1, 19 and 20:

Saari et al. discloses a method comprising:

identifying one or more underlying services utilized to execute the computer transaction (see generally cols. 1-2, abstract, claims); and

determining a cost associated with the one or more services to execute the transaction as a function of the usage of the services (see Figs. 1-13 and the description thereof).

Saari et al. further discloses a computer system to perform the steps recited above.

W.R.T. Claims 2-18:

Saari et al. further discloses the method comprising:

wherein the determining step includes determining a cost for providing the services (see Figs. 2-13 and the description thereof);

wherein the providing cost includes a software cost and the determining step includes calculating the software cost as a percentage of an overall software cost (see cols. 1 and 2; and Figs. 1-13 and the description thereof; col. 4, lines 18-42);

wherein the providing cost includes an equipment cost and the determining step includes calculating the equipment cost as a percentage of an overall equipment cost (*Id.*);

wherein the providing cost includes a personnel cost and the determining step includes calculating the personnel cost as a percentage of an overall personnel cost (see *Supra*);

wherein the providing cost includes a facility cost and the determining step includes calculating the facility cost as a percentage of an overall facility cost (see cols. 1 and 2; and Figs. 1-13 and the description thereof; col. 4, lines 18-42);

wherein the determining step includes determining a cost for a level of quality of the one or more services (*Id.*);

wherein the step of determining a cost for the quality of the services includes determining a cost for the availability of the services (see cols. 1 and 2; and Figs. 1-13 and the description thereof; col. 4, lines 18-42);

wherein the availability cost includes an equipment cost and step of determining a cost for the availability includes calculating the equipment cost as a percentage of an overall equipment cost (*Id.*);

wherein the availability cost includes a software cost and step of determining a cost for the availability includes calculating the software cost as a percentage of an overall software cost (see cols. 1 and 2; and Figs. 1-13 and the description thereof; col. 4, lines 18-42);

wherein the availability cost includes a personnel cost and step of determining a cost for the availability includes calculating the personnel cost as a percentage of an overall personnel cost (*Id.*);

wherein the availability cost includes a facility cost and step of determining a cost for the availability includes calculating the facility cost as a percentage of an overall facility cost (see *Supra*);

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wherein the step of determining a cost for the quality of services includes determining a cost to the response time of the services (see cols. 1 and 2; and Figs. 1-13 and the description thereof; col. 4, lines 18-42);

wherein the response time cost includes an equipment cost and step of determining a cost for determining a cost for the response time includes calculating the equipment cost as a percentage of an overall equipment cost (*Id.*);

wherein the response time cost includes a software cost and step of determining a cost for determining a cost for the response time includes calculating the software cost as a percentage of an overall software cost (see *Supra*);

wherein the response time cost includes a personnel cost and step of determining a cost for determining a cost for the response time includes calculating the personnel cost as a percentage of an overall personnel cost (see cols. 1 and 2; and Figs. 1-13 and the description thereof; col. 4, lines 18-42);

wherein the response time cost includes a facility cost and step of determining a cost for determining a cost for the response time includes calculating the facility cost as a percentage of an overall facility cost (*Id.*); and

wherein the determining step includes determining a cost for providing the services and the determining step includes determining a cost for a level of quality of services, including the step of combining the providing cost and the quality cost to define a transaction cost (see cols. 1 and 2; and Figs. 1-13 and the description thereof; col. 4, lines 18-42).

W.R.T. Claim 21:

Saari et al. discloses a computer-readable medium having a computer-executable service cost component including data indicative of a determination of a computer transaction cost as a function of services (see cols. 1 and 2; and Figs. 1-13 and the description thereof; col. 4, lines 18-42).

W.R.T. Claims 22-29:

Saari et al. discloses the medium comprising:

wherein the service cost component includes data indicative of the cost of providing one or more services (see cols. 1 and 2; and Figs. 1-13 and the description thereof; col. 4, lines 18-42);

wherein the service cost component includes data indicative of an equipment cost of providing one or more services (*Id.*);

wherein the service cost component includes data indicative of a software cost of providing one or more services (see *Supra*);

wherein the service cost component includes data indicative of a personnel cost of providing one or more services (see cols. 1 and 2; and Figs. 1-13 and the description thereof; col. 4, lines 18-42);

wherein the service cost component includes data indicative of a facility cost of providing one or more services (*Id.*);

wherein the service cost component includes data indicative of the cost of the one or more services (*Id.*);

wherein the service cost component includes data indicative of the cost of availability of one or more services (see cols. 1 and 2; and Figs. 1-13 and the description thereof; col. 4, lines 18-42);

wherein the service cost component includes data indicative of the cost of a response time of one or more services (*Id.*).

W.R.T. Claims 30, 34 and 35:

Saari et al. discloses a method comprising:

requesting, by a user process, execution of a transaction (see cols. 1 and 2; and Figs. 1-13 and the description thereof; col. 4, lines 18-42);

receiving the user process request (*Id.*);

executing the user process request; and

determining a cost associated with the execution of the transaction as a function of the services (see *Supra*).

Saari et al. further discloses a computer system and computer-readable medium performing the method claim as recited above.

W.R.T. Claims 31-33:

Saari et al. discloses the method comprising:

wherein the determining step includes determining a providing cost of the services (see cols. 1 and 2; and Figs. 1-13 and the description thereof; col. 4, lines 18-42);

wherein the determining step includes determining a quality cost of the services (*Id.*); and

wherein the step of determining a providing cost of the services includes determining an availability cost and a response time cost (see cols. 1 and 2; and Figs. 1-13 and the description thereof; col. 4, lines 18-42).

W.R.T. Claims 36, 41, 42:

Saari et al. discloses a method comprising:

associating an identifier with the transaction (see cols. 1 and 2; and Figs. 1-13 and the description thereof; col. 4, lines 18-42);

identifying services (*id.*);

monitoring a service record to associate an availability of the services (see *Supra*); and

monitoring the service record to associate a response time of the services.

Saari et al. discloses a computer-readable medium and a computer system performing the method claim as recited above (see cols. 1 and 2; and Figs. 1-13 and the description thereof; col. 4, lines 18-42).

W.R.T. Claims 37-40:

Saari et al. further discloses the method comprising:

wherein the identifier is an open-handle identifier (see cols. 1 and 2; and Figs. 1-13 and the description thereof; col. 4, lines 18-42);

the monitoring steps include monitoring a network service record (*Id.*);

wherein the network is Internet;

associating an individual user with the computer transaction (see cols. 1 and 2; and Figs. 1-13 and the description thereof; col. 4, lines 18-42).

Conclusion

8) The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

US 6,247,047 is cited to show a method and apparatus for facilitating computer network transactions. The computer network connects a host node and at least one user node.

US 6,086,618 is cited to show a method and computer program product for developing system resources usage cost equations, creating models based upon such cost equations, and estimating total system resource usage.

US 5,625,690 is cited to show a pay per use system for of the unauthorized use of computer software. An encryption program encodes original software to produce secured software.

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"The Meter is Running" is cited to show a network billing scheme and policy.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Richard Woo whose telephone number is 703-308-7830. The examiner can normally be reached on Monday-Friday from 8:30 AM -5:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Weiss can be reached on 703-308-2702. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9306 for regular communications and After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0861.



Richard Woo
Patent Examiner
GAU 3629
September 30, 2003



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